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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/634,497      | 08/05/2003  | Martin Grohman       | 34192               | 8665             |

7590 01/21/2005

Hovey Williams LLP  
Suite 400  
2405 Grand Blvd.  
Kansas City, MO 64108

| EXAMINER |
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SLACK, NAKO N

| ART UNIT | PAPER NUMBER |
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|----------|--------------|

3635

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/634,497 | <b>Applicant(s)</b><br>GROHMAN, MARTIN |  |
|                              | <b>Examiner</b><br>Naoko Slack       | <b>Art Unit</b><br>3635                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-16 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/30/04, 7/19/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statements***

Information Disclosure Statements received January 30, 2004 and July 19, 2004 have been entered and considered.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "34" has been used to designate both a projection on a spacer (Figure 3) and an upper inner surface of a decking groove (Figure 4).

Also, reference character "36" has been used to designate both a projection on a spacer (Figure 5) and a lower inner surface of a decking groove (Figure 4). Finally, reference character "38" has been used to designate both the top portion of a spacer (Figure 5) and an innermost surface of a decking groove (Figure 4).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections – 35 USC 102***

The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 112 (b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7, 11-13 are rejected under 35 USC 102(e) as being clearly anticipated by US Patent Application Publication US 2003/0123924 A1 to Eberle III (hereinafter referred to as Eberle).

Claim 1:

Eberle discloses a board comprising an elongated body of similarly configured sides (57, Figure 7), each of the sides including a normally-upper lip and a normally-lower lip, the sides including a longitudinal groove (57) defined between the normally-upper lip and normally-lower lip, the groove including an innermost surface, and the normally-upper lip (61, Figure 8) extending further from the innermost surface than the normally lower lip (63, Figure 8).

Claims 2 and 12:

As best illustrated in Figure 8, the normally-upper lip (61) extends at least 10 percent further from the innermost surface than the normally-lower lip (63).

Claims 3 and 13:

As best illustrated in Figure 8, the normally-upper lip (61) extends at least 20 percent further from the innermost surface than the normally-lower lip (63).

Claim 4:

The similarly configured sides are located on generally opposite sides of the body (as best illustrated in Figure 8).

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Claim 5:

The normally-upper lip portion presents a rounded distal portion (61, Figure 8).

Claim 7:

The normally-upper and the normally-lower lips present opposing inwardly facing surfaces cooperatively defining at least a portion of the groove (55, Figure 8).

Claim 11:

Eberle discloses a deck system comprising a plurality of laterally spaced joists (59) and a plurality of substantially parallel boards (53) extending across and supported by the joists, each of the boards including a pair of generally opposite similarly configured sides (Figure 8), each of the sides including an upper lip (61), a lower lip (63), and a groove (55) defined between the upper and lower lips, the lower lip being disposed closer to the joists than the upper lip, the upper lip protruding further than the lower lip (as best shown in Figure 8).

### ***Claim Rejections – 35 USC 103***

The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 USC 103(a) as being unpatentable over US Patent Application Publication US 2003/0123924 A1 to Eberle III (hereinafter referred to as Eberle).

Claim 14:

While Eberle III does not specify board spacing from 0.1 to 0.75 inches, Eberle's anchoring device is formed with critical dimensions to enable maximum support of adjacent boards with a minimum of spacing between the boards (page 4, first paragraph). Therefore, it would have been obvious to one of ordinary skill in the art to construct Eberle's decking with a spacing as small as possible, such as 0.1 to 0.75 inches.

Claims 6, 8-10, 15 and 16 are rejected under 35 USC 103(a) as being unpatentable over US Patent Application Publication US 2003/0123924 A1 to Eberle III (hereinafter referred to as Eberle) as applied to claim 1 above, and further in view of the article "Architectural House Plans" by Graham (hereinafter referred to as Graham).

Claims 6, 10, 15, and 16:

While Eberle discloses that extruded plastic decking boards are well known in the art (page 3, paragraph 0024), Eberle does not specify a board formed of a composite of cellulosic fiber and plastic. However, such a composite is well known in the building art, as taught by Graham. Graham discloses composites made from wood fiber and plastic, citing the benefits of moisture and decay resistance (page 1, paragraph 3). In view of Graham, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form Eberle's decking board with an extruded wood fiber and plastic composite for

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the cited benefits of moisture and decay resistance, as Eberle's decking boards are exposed to environmental elements.

Claims 8 and 9:

The inwardly facing surfaces of Eberle's groove are spaced approximately one quarter the total thickness of the board (Figure 8). Therefore, a decking board thickness of 2 inches, as cited by Graham (page 2, last paragraph) means that the spacing of the groove would be approximately .5 inch.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (703) 305-0315. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Carl D. Friedman can be reached at (703) 308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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A handwritten signature in black ink, appearing to read 'Naoko Slack', with a long horizontal stroke extending to the right.

Naoko Slack  
Primary Examiner

NS  
January 17, 2005